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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,559	06/04/2002	Staffan Skogvall	33891R005	5012

7590 10/21/2004

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EXAMINER

MCKENZIE, THOMAS C

ART UNIT PAPER NUMBER

1624

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/009,559

**Applicant(s)**

SKOGVALL, STAFFAN

**Examiner**

Thomas McKenzie, Ph.D.

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-31 is/are pending in the application.
- 4a) Of the above claim(s) 24-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/22/02 & 12/14/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This action is in response to a second amendment filed on 8/18/04 and supplemental to the office action mailed 9/2/04. Applicants have amended claims 18-21. Claims 22-31 are new. There are fourteen claims pending and six under consideration. Claims 18-23 are method of using claims. This is the second action on the merits. The application concerns some uses of the compound RS 67333. RS-67333 appears to be the substance 1-(4-amino-5-chloro-2-methoxyphenyl)-3-(1-butyl-4-piperidiny)-1-propanone.

2. Applicants' second amendment crossed in the mail with the first action on the merits dated 9/2/04. According to MPEP §714.05, "[t]he supplemental action \*\*\* need not reiterate all portions of the previous action that are still applicable but it should specify which portions are to be disregarded, pointing out that the period for reply runs from the mailing of the supplemental action."

3. The withdrawal from consideration of claims 5-13 made in point #3 of the previous action is to be disregarded since the claims are no longer pending. The indefiniteness and utility rejections made to claims 1-3 in point #9 of the previous action are to be disregarded since the claims 1-3 are no longer pending. The indefiniteness rejection concerning "preferably" in claims 19 and 21 made in point #10 is to be disregarded since Applicants have eliminated the word from their pending claims. The enablement rejection concerning preventing diseases in

claims 18-21 made in point #13 is to be disregarded since the claims no longer concern preventing. The anticipation rejections to claims 1-3 made in point #14 are to be disregarded since claims 1-3 are no longer pending.

***Election/Restrictions***

4. Parts of claims 22 and 23 are newly withdrawn from consideration because art was found concerning RS 67333 and asthma treatment (see MPEP 803.02.).

5. Objection is newly made to claims 22 and 23 as containing non-elected subject matter. The claimed compositions and methods that employ them present a variable core. These claims contain compounds drawn to the non-elected species.

6. Claims 24-31 are newly withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/11/04.

***Claim Rejections - 35 USC § 112***

7. Claims 22 and 23 are newly rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What is RS 67333? This was discussed in point #8 of the previous office action.

8. Claims 22 and 23 are newly rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for treating asthma with compositions of RS 67333 for reasons discussed in point #12 of the previous office action.